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10/623,278	07/18/2003	Anne E. Spinks	99-113-US-02	2410

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EXAMINER

LONEY, DONALD J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/623,278
Filing Date: July 18, 2003
Appellant(s): SPINKS, ANNE E.

Allison Johnson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 10, 2007 appealing from the Office action mailed February 27, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,569,516	PAEGLIS ET AL	10-1996
5,851,609	BARATUCI ET AL	12-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Baratuci et al (5851609).

Baratuci et al teaches an adsorbent composition comprising 5-15 wt % amorphous polyalphaolefin and 1-50% of a moisture adsorbent. Refer to column 5, lines 12-32 and column 6, line 68. The composition is free of a butyl rubber or polyisobutylene film forming agent since in column 5, lines 56-59 Baratuci et al discloses that other polymers instead of these may be included. Therefore, there would be no a butyl rubber or polyisobutylene film forming agent as recited in the claim.

3. Claim 1, 2, 7, 12, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Paeglis et al (5569516).

Paeglis et al discloses a composition comprising up to 40 % polyalphaolefin and 10-80% adsorbent per claims 1 and 14. The adsorbent is for volatile organic materials (i.e. oils) per claims 1 and 7. Refer to column 5, lines 42-46 and column 8, lines 27-40. The examiner deems the polyalphaolefin as being inherently amorphous due to its low degree of crystallinity. The crystallinity is disclosed as low as 2% at column 5, lines 61 through column 6, line 16. The applicant indicates that amorphous is a low degree of crystallinity at page 4, line 16, with no numerical guidance as what "low" is. The examiner has cited US Pat. No. 4614778 to Kajiura et al as a teaching reference as to less than 40% crystallinity is considered low and amorphous alpha-olefin copolymers (see column 8, lines 4-9). With regards to claim 2, see column 5, lines 39-46. With regards to claims 12 and 13, drawn to "consisting essentially of", they are included since the applicant from page 2, line 21 of the specification is attempting to exclude polyisobutylene and butyl rubber from the recited composition using said limitation. Also, from MPEP section 2111.03, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. Any additional materials in the prior art must be shown to materially effect the composition due to the "consisting essentially of" recitation, which allows other materials not materially affecting the composition.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 3-6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paeglis et al.

The primary reference teaches the invention substantially as recited except for the flow rates per claims 3-6. See the 35 U.S.C. 102 rejection above. Paeglis et al does disclose flow rates from a different test at column 6, lines 64-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to Paeglis et al to form the composition with flow rates as recited motivated by the fact one would use what ever flow rate is need for a particular application. A particular application disclosed in Paeglis et al is for use in glazings

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(column 8, lines 61-66), which the same field the applicant uses the recited low flow melt composition in. With respect to claims 8 and 9, one would be motivated to form the composition of the recited properties since Paeglis et al discloses the composition being used in the same filed as the applicant (i.e. glazings as indicated above).

7. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paeglis et al in view of the applicants discussion of the prior art ADPA.

The primary reference teaches the invention substantially as recited except for the specific adsorbents recited in claims 18-20.

The ADPA on page 5, lines 10-25 disclose that the adsorbents are commercially available.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Paeglis et al to substitute one adsorbent for another motivated by the fact Paeglis et al discloses adsorbents included in the composition and the ADPA teaches the specific ones recited are commercially available.

(10) Response to Argument

Appellant's arguments over Baratuci et al (5851609).

Appellant argues that Baratuci et al does not teach a composition as recited and that their preferred composition includes butyl rubber and/or polyisobutylene which the appellant excludes from the claim. However, Baratuci et al does disclose that other polymers, which form the two component composition, besides butyl rubber and/or polyisobutylene can be used (column 5, lines 56-59) and the recited amorphous

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polyalphaolefins are disclosed in column 5, line 52 through column 6, line 5. The percent adsorbent is disclosed in column 5, lines 16-18. Therefore, Baratuci et al does disclose a composition containing amorphous polyalphaolefin and the recited percent adsorbent that is free of the film forming agent recited in claim 14.

Appellant's arguments over Paeglis et al (5569516).

Appellant argues that the oils disclosed in Paeglis et al are not inherently volatile. However, it is the examiners position that they are volatile to at least some degree and since Paeglis et al discloses the composition (i.e. polyalphaolefin and adsorbent) the claims are still met therefrom. The appellant also argues that the composition of Paeglis et al adsorbs oil from the formulation and not necessarily from an atmosphere from which it is exposed. As previously indicted, the membrane itself is part of and/or included in the atmosphere to which the composition is exposed or included therein. With regards to claims 12 and 13, the appellant argues that the composition of Paeglis et al includes a plasticizer oil which is excluded due to the appellants use of "consisting essentially of". However, as explained above this terminology is used in order to exclude the film forming agents as indicted in the specification, therefore, it does not exclude the other materials in Paeglis et al. With regards to claims 3-5, the appellant argues that there is no motivation to indicate the flow rates would be obvious to one of ordinary skill in the art. However, since Paeglis et al discloses the composition useful in seals, glazings and many other applications at column 8, lines 61-67 it would be obvious to one of ordinary skill in the art to form the composition of what ever flow rate is needed for a particular application. With regards to claim 6, the appellant argues that

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Paeglis et al fails to disclose the percent adsorbent, however, it would be obvious to one of ordinary skill in the art to form the composition of a higher percent adsorbent in order to be more adsorbent if needed for a particular application. With regards to claims 8 and 9, the appellant argues that the properties therein would not be obvious from the prior art. However, to claims 8 and 9, one would be motivated to form the composition of the recited properties since Paeglis et al discloses the composition being used in the same filed as the applicant (i.e. seals, glazings and many other applications as indicated above).

Appellant's arguments over Paeglis in view of the applicant's discussion of the prior art (ADPA).

Appellant argues that the particular adsorbents recited in claims 18-20 would not be obvious from the prior art. However, as indicated above to substitute one adsorbent for another would be obvious motivated by the fact Paeglis et al discloses adsorbents included in the composition and the ADPA teaches the specific ones recited are commercially available.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Donald J. Loney/

Primary Examiner

Art Unit 1794

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